

Doc Code: AP.PRE.REQ

SEP 29 2005

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx  
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

## PRE-APPEAL BRIEF REQUEST FOR REVIEW

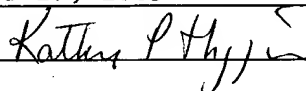
Docket Number (Optional)

P23,305-A USA

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on September 27, 2005

Signature

Typed or printed  
name

Kathy P. Higgins

Application Number

09/935,287

Filed

August 22, 2001

First Named Inventor

Joshua M. Kopelman

Art Unit

3627

Examiner

G. O'Connor

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒

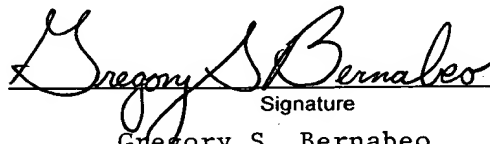
attorney or agent of record.

Registration number 44,032

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34



Signature

Gregory S. Bernabeo

Typed or printed name

215-923-4466

Telephone number

September 27, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

☐

\*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



**ARGUMENTS FOR WHICH REVIEW IS REQUESTED**

Review is requested for the arguments and remarks below.

**Claim 1**

Independent claim 1 is directed to a computer-implemented method for listing goods for sale that includes "receiving from a seller information identifying a good, the information comprising a series of tones generated by depression of keys of a telephone."

Lalonde fails to teach or suggest "receiving from a seller information identifying a good, the information comprising a series of tones generated by depression of keys of a telephone." In Lalonde, while the system may include an IVR receiving tones generated by depression of keys of a telephone, such information is information only in a general sense, e.g. to navigate through a voice prompt system of an IVR. Such tones do not convey information identifying a good.

Further, Lalonde's IVR system may be used for various functions. However, if the caller is a seller asking to place a new ad in the system, the system routes control away from the IVR system. Col. 5, lines 53-55; Figure 2, blocks 112, 114, 116; col. 5, lines 29-51. Accordingly, to the extent that an IVR system is used in Lalonde, it is not used in the manner contemplated by the claimed invention; Lalonde's IVR does not receive information identifying a good in the form of a series of touch tones generated by depression of keys of a telephone.

Lalonde, at col. 6, lines 14-18, states that "this step could be automated using the IVR." The identity of the referenced step is unclear. However, it is believed that "this step" refers to the step discussed in the same paragraph (col. 6, lines 3-18), namely, the method step shown at block 116 in the referenced method flowchart of

Figure 2, which reads "send [operator] request message to DBS." Accordingly, Lalonde does not disclose receiving information identifying a good in the form of a series of touch tones generated by depression of keys of a telephone.

Lalonde fails to teach or suggest all limitations of claim 1.

### Claims 3-8

Claim 3 further recites that "the series of tones comprises tones generated by depressing the telephone's keys in a sequence corresponding to an alphanumeric sequence of a standard identification code." Claims 4 and 5 recite that the standard identification code is a UPC or ISBN, respectively. There is absolutely no teaching or suggestion of any use of UPC, ISBN or other standard codes in Lalonde.

Further, even if Lalonde's reference to "this step" at col. 6, lines 3-18 could be interpreted to refer to an IVR's collection of good-related information, which is believed improper, Lalonde further states that it is preferable to "use a human operator as an interface, because of the amount of variability involved in placing an ad, explaining to the seller the options available, etc." Col. 6, lines 14-18. Having arguably disclosed a problem or challenge to using an IVR in substitution for a human operator, Lalonde has not disclosed a solution to that problem/challenge. Further, it is noted that the undersigned can envision ways to identify a good for sale using an IVR that do not involve use of a standard identification code.

Further, there cannot be motivation to make the proposed modification of Lalonde because the system/method provides for a human operator's receipt of information from a seller. Thus, use of touch tones to provide good related information, which would be unrecognizable to the human operator, would render the human operator unsatisfactory for its intended purpose of gathering information

from a seller, or would change the principle of operation of selectively routing calls to a human operator and/or render the system unsatisfactory for its intended purpose.

#### Claims 9, 10, 21 and 22

Claims 9 and 10 recite "the sale price being information relating to the good is retrieved from the database." This is neither taught nor suggested by Lalonde.

Further, the Examiner has not asserted otherwise, and thus has not met the obligation of establishing a *prima facie* case of obviousness.

Further, it is noted that this retrieval of sale price information from a database is part of the process of a seller's listing of a good for sale, not part of the buyer's browsing process. Lalonde provides absolutely no teaching or suggesting of retrieving information relating to a good, such as sale price information, from a database as part of the process of listing an item for sale. Lalonde's disclosure of retrieving information from a database relates only to the buyer's buying process, i.e., presenting previously stored ad information to a buyer.

Claims 21 and 22 are similar to claims 9 and 10, but further relate to use of standard identification codes to retrieve a price recommendation from the database. This is neither taught nor suggested by Lalonde.

#### Claims 11 and 12

Contrary to the Examiner's assertion that merely restates the claim language, Lalonde provides absolutely no teaching or suggestion of any recognizable seller identification code associated with a seller.

Lalonde fails to teach or suggest all claim limitations. See Applicants' Reply filed May 13, 2005, pages 15-16.

### Claims 23-32

Claims 23-32 present include recitations that are neither taught nor suggested by the cited art. See Applicants' Reply filed May 13, 2005, pages 17-19.

Further, certain of these claims recite limitations not found in a preceding claim. See, e.g., claim 24 reciting that the series of tones identifies "a characteristic of the good that is incapable of being discerned from the standard identification code."

The Examiner has not even asserted that the recitations of these claims (e.g., claim 24) are taught or suggested by the prior art, and thus has not met the burden of establishing a prima facie case of obviousness.

### Examiner Arguments

Requested also is review of the Examiner's assertions in the Action dated 7/27/05 at paragraph 11, and at pages 5-6 regarding claim 13. These arguments, particularly with respect to the asserted motivation, are traversed.